## REMARKS

Applicants have amended Claims 1 and 21, the pending independent claims. No claim has been cancelled. Accordingly, Claims 1-3, 21-28, and 32-36 remain pending.

Applicants respond below to the specific rejections and objections raised by the Examiner in the Office Action of November 18, 2003.

Rejections Under 35 U.S.C. § 112

Claims 1 and 21 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly not being enabled. While the Examiner agrees that the specification is enabled for "the ferrate is contacted with the object it is to oxidize, synthesize, disinfect, clean, plate, encapsulate, or coagulate," a phrase that appears verbatim in the specification at, *inter alia*, lines 4-6 of paragraph [0047], the Examiner states that the phrase "said ferrate is used in the oxidization, synthesis, disinfection, cleaning, plating, encapsulating, or coagulating an object" found in Claims 1 and 21, which is a grammatical variant of the sentence found in the specification, is not enabled. The Examiner alleges that the latter phrase is of much broader scope than the sentence found in the specification.

Applicants respectfully disagree and maintain that the two phrases are nearly identical in scope and description. However, in order to expedite prosecution and advance the case towards allowance, without narrowing the pending claims Applicants have amended Claims 1 and 21, the two pending independent claims, and have replaced the objected-to phrase with the phrase found verbatim in the specification. Applicants respectfully maintain that these two phrases are functionally identical and cover the same scope. Consequently, the present amendments do not narrow the scope of the claims.

Further, Claims 1 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. The Examiner argues that it is not clear what the ferrate is used for. Applicants respectfully disagree and maintain that the claim language on its face is clear and that those of skill in the art know that ferrate is used for oxidization, synthesis, disinfection, cleaning, plating, encapsulating, or coagulating an object by contacting ferrate with said object. Skilled artisans know, and the specification makes clear, that ferrate is chemical reagent and a strong oxidant and it is used in that capacity and not for "barter or for sale," as the Examiner suggests.

However, Applicants amendments described above make this issue moot because the "used in" phrase is now replace with the phrase found verbatim in the specification.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. § 112.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-3, 21-25, 27, 28, and 32-36 stand rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over Minevski et al. (USP 6,471,788). Claim 26 stands rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over Minevski et al. in view of Deininger '573.

Though the Examiner does not specifically point out the statutory bases upon which Minevski et al. is allegedly prior art, Applicants presume that Minevski et al. is allegedly prior art against the present application under 35 U.S.C. § 102(e)(2). Minevski et al. issued on October 29, 2002, based on an application that was filed on December 15, 1999. No other priority claim was made.

In Paper No. 8 of the present application, mailed May 1, 2003, the Examiner has acknowledged the Applicants' claims to priority under 35 U.S.C. 120 and 119(e). The pending claims are fully supported by the disclosure of U.S. Provisional Application Serial No. 60/218,409, filed on July 14 2000. See e.g., pages 4 through 11. Accordingly, Minevski et al. is unavailable as a prior art printed publication or patent under 35 U.S.C. §§ 102(a) and (b). If Minevski et al. is available as prior art at all, it would only be available under 35 U.S.C. § 102(e), as the application upon which it is based was filed before the earliest priority date of the present application. As explained below and in the accompanying declaration under 37 CFR § 1.131 of Lee E. Ciampi, however, Minevski et al. is not available as prior art under § 102(e), because the date on which the presently claimed invention was made occurred before the Minevski et al. application was filed.

Without acquiescing to the Examiner's characterization of the disclosure of Minevski et al. and its alleged relevance to the subject matter of the presently pending claims, Applicants respectfully submit that date of invention for the presently claimed invention is prior to December 15, 1999. The Declaration under 37 C.F.R. § 1.131 of Lee E. Ciampi, filed herewith, establishes that Minevski et al. is not available as prior art under § 102. This declaration

establishes completion of the invention of Claims 1-3, 21-28, and 32-36 before the date upon which Minevski et al. became available as prior art under 35 U.S.C. § 102(e)(2).

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. § 103(a).

Change in Inventorship

As a result of the prosecution of the captioned non-provisional application, fewer than all of the originally named inventors are the actual inventors of the invention now-claimed; Mr. Lee Ciampi is now the sole inventor of the invention claimed in Claims 1-3, 21-28, and 32-36. Accordingly, Applicants have filed herewith a request for correction of inventorship under 37 C.F.R. § 1.48(b), deleting the names of Mr. Gregory F. Smith and Mr. Bernie Knoble. Applicants submit that they intended to file such a request when a set of claims were allowed. Because Applicants believe that the present amendments and response places the present application in condition for allowance, Applicants file the request or correction of inventorship at this time.

## CONCLUSION

Applicants have endeavored to respond to all of the Examiners comments and rejections. Applicants respectfully submit that the claims, as amended herewith, are patentable and should be passed to issue. A notice to that effect is respectfully requested.

No fee is believed due in connection with this response. If this is not correct, please charge any required fees, including any fees for extension of time, to Deposit Account No. 11-1410. The Examiner is invited to call Applicant's representative at the number listed below if any issues can be resolved telephonically.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 2/17/04

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